

to the claims merely clarify the claims, in part, as suggested by the Examiner. Applicants respectfully request that these amendments be entered.

#### REMARKS

With these amendments, claims 1-21 are pending. The Action objects to the title of the invention. The Action also rejects claims under 35 U.S.C. § 112, second paragraph, for alleged indefiniteness and under 35 U.S.C. § 103(a) for alleged obviousness.

#### THE OBJECTION RELATING TO THE TITLE OF THE INVENTION IS MOOT

The Action objects to the title of the invention for allegedly being too broad. Applicant has amended the title of the invention as helpfully suggested by the Examiner. Accordingly, Applicant respectfully requests that this objection be withdrawn.

#### AMENDED CLAIM 21 IS NOT INDEFINITE

The Action rejects claim 21 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Applicant has made non-narrowing amendments to further clarify claim 21. In particular, amended claim 21 provides, in part, that the device comprises a housing comprising a front surface and a back surface, the front surface comprising an upper region and a lower region, an input keypad in or proximal to the upper region, the input keypad comprising input keys for inputting each number in a ten digit system, and a display screen in or proximal to the lower region, the display screen providing an output for at least one or more numbers inputted from the input keypad or for stored or received data. As a consequence, Applicant respectfully requests that this rejection be withdrawn.

#### THE CLAIMED INVENTION IS NOT OBVIOUS

The Action rejects claims 1, 3-19, and 21 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Slipy et al. (U.S. Pat. No. 5,848,152, hereinafter, Slipy) in view of Collins (U.S. Pat. No. 6,038,313, hereinafter, Collins). Applicants traverse each of these rejections as noted below.

To establish a *prima facie* case of obviousness, *inter alia*, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, M.P.E.P. §

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2142. Slipy and/or Collins do(es) not teach or even suggest all the limitations of independent claims 1, 18, or 21, which relate to a portable electronic device, a method of manufacturing a portable electronic device, and a method of using a portable electronic device, respectively. More specifically, the portable electronic device of claim 1 includes a housing that includes a front surface and a back surface, the front surface including an upper region and a lower region, an input keypad in or proximal to the upper region, the input keypad including input keys for inputting each number in a ten digit system, and a display screen in or proximal to the lower region, the display screen providing an output for at least one or more numbers inputted from the input keypad or for stored or received data. The method of manufacturing a portable electronic device of claim 18 includes forming a housing, a display screen, and input keys using one or more fabrication technique in which the housing includes a front surface and a back surface, and in which the front surface includes an upper region and a lower region. The method of claim 18 further includes assembling the display screen and the input keypad in or on the front surface such that the input keys are disposed in or proximal to the upper region and the display screen is disposed in or proximal to the lower region in which the input keys are assembled in or on the front surface into an input keypad that includes input keys for each number in a 10 digit system. The method of using a portable electronic device of claim 21 includes holding the device in at least one hand of a user and positioning the device proximal to a head of the user in which the user engages the device by viewing the display screen, operating the input keypad with at least one finger on the at least one hand, listening to sounds produced by at least one speaker disposed in the device, speaking into at least one microphone disposed in the device, or by performing a simultaneous or non-simultaneous combination thereof.

In contrast to the claimed invention, neither Slipy nor Collins teaches or even suggests including an input keypad in or proximal to an upper region in which the input keypad includes input keys for inputting each number in a ten digit system and a display screen in or proximal to a lower region. In particular, Slipy merely purports to disclose a conventionally configured communication device having interchangeable faceplates. Indeed, the Action even acknowledges that Slipy does not teach these limitations. *See*, Action at page 4. Similarly, Collins, which alleges a telephone having a hinged flap with a keyboard one each side, also does

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not teach or suggest the claimed invention. Specifically, the passages cited from Collins do not disclose a device that includes an input keypad in or proximal to an upper region in which the input keypad includes input keys for inputting each number in a ten digit system and a display screen in or proximal to a lower region. Instead, Collins merely asserts a conventional device having an input keypad for inputting numbers in a ten digit system, which input keypad is disposed below or covering a display screen dependent upon whether the flap is open or closed. As a consequence, whether viewed independently or in combination, the cited publications simply do not teach or even suggest all the limitations of the claimed invention. Therefore, the Action fails to establish a *prima facie* case of obviousness and the rejections should be withdrawn.

The Action must also establish a clear motivation to modify Slipy or Collins, or to combine their teachings to produce the claimed invention. Applicants respectfully submit that the Action does not articulate any such supposed motivations. In addition, the cited passages from the publications do not supply any motivation to modify their teachings to achieve the invention as claimed. Further, even if there were a motivation to combine the teachings of the cited art at the time the subject invention was made, which Applicant does not concede existed, the claimed invention would simply not be produced for the reasons provided above.

In summary, the cited publications do not teach every element of independent claims 1, 18, or 21 and no motivation to combine or modify the art has been articulated in the Action. Since the rejected independent claims are non-obvious, the rejected dependent claims are also necessarily non-obvious. Accordingly, as the Action fails to establish a *prima facie* case of obviousness, Applicant respectfully requests that all of these rejections be withdrawn.

REQUEST FOR A CORRECTED FILING RECEIPT

Applicants respectfully request a corrected filing receipt in view of the changes to the title.

CONCLUSION

In view of the foregoing, the Applicant believes all claims now pending in this Application are in a condition for allowance. Applicant notes that claims 2 and 20 were

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indicated to include allowable subject matter. The issuance of a formal Notice of Allowance at an early date is respectfully requested. If the Examiner believes a telephone conference would expedite prosecution of this Application, please telephone the undersigned at 510-337-7871.

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Respectfully submitted,



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Made

21 (Amended). A method of using a portable electronic device, the method comprising:

holding the device [of claim 1] in at least one hand of a user, wherein the device comprises:

a housing comprising a front surface and a back surface, the front surface comprising an upper region and a lower region;

an input keypad in or proximal to the upper region, the input keypad comprising input keys for inputting each number in a ten digit system; and

a display screen in or proximal to the lower region, the display screen providing an output for at least one or more numbers inputted from the input keypad or for stored or received data; and,

positioning the device proximal to a head of the user, wherein the user engages the device by viewing the display screen, operating the input keypad with at least one finger on the at least one hand, listening to sounds produced by at least one speaker disposed in the device, speaking into at least one microphone disposed in the device, or by performing a simultaneous or non-simultaneous combination thereof.

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